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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/542,966

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Guillermo J. Tearney

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EXAMINER

THOMAS, BRANDI N

ART UNIT

PAPER NUMBER

2873

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/542,966	<b>Applicant(s)</b> TEARNEY ET AL.	
	<b>Examiner</b> BRANDI N. THOMAS	<b>Art Unit</b> 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-145 is/are pending in the application.
- 4a) Of the above claim(s) 16-38,40-74,76-108 and 110-145 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15,39,75 and 109 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/20/05</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of claims 1-15, 39, 75, and 109 in the reply filed on 4/10/08 is acknowledged.
2. Claims 16-38, 40-74, 76-108, and 110-145 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/10/08.

### *Information Disclosure Statement*

3. Acknowledgement is made of receipt of Information Disclosure Statement(s) (PTO-1449) filed 7/20/05. An initialed copy is attached to this Office Action.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-15, 39, 75, and 109 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krauter (5191879) in view of Garini (6552794 B2).

Regarding claims 1, 75, and 109, Krauter discloses, in figures 2 and 3, a confocal microscope lens arrangement, comprising: a lens assembly housing (23) including a lens assembly (21) (col. 3, lines 33-35); an exterior housing (20) including a distal end (26)

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and a proximal end (27) (col. 3, lines 44-49), the exterior housing (figure 2) configured to allow the lens assembly housing (20) to be placed therein, and translated between the proximal end (27) and distal end (26) of the exterior housing (figure 2) to focus the lens assembly (20) (col. 3, lines 44-49); an area filling the volume of area between the exterior housing (20) and the lens assembly housing (23) (figures 2 and 3) but does not specifically disclose an immersion media. Garini discloses an immersion media used in a variable focus camera (col. 6, lines 42-50). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the device of Krauter with the immersion media of Garini for the purpose of correcting aberrations.

Regarding claim 2, Krauter discloses, in figures 2 and 3, a confocal microscope lens arrangement, wherein the exterior housing (20) is dimensioned such that a clearance area is provided between the lens assembly housing (23) and the exterior housing (20) (figures 2 and 3).

Regarding claims 3 and 4, Krauter discloses, in figures 2 and 3, a confocal microscope lens arrangement, wherein the clearance area is sized to allow a portion of the air to flow from the distal end of the exterior housing to the proximal end of the exterior housing when the lens assembly is translationed toward the distal end of the exterior housing (20) (figures 2 and 3) but does not specifically disclose an immersion media. Garini discloses an immersion media used in a variable focus camera (col. 6, lines 42-50). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the device of Krauter with the immersion media of Garini for the purpose of correcting aberrations.

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Regarding claims 5 and 10, Krauter discloses, in figures 2 and 3, a confocal microscope lens arrangement, wherein the distal end (26) of the exterior housing (20) comprising a coverslip (figures 2 and 3) but does not specifically disclose an aperture, and wherein the coverslip is placed in registration with the aperture. Garini discloses an aperture and a coverslip, and wherein the coverslip is placed in registration with the aperture (col. 6, lines 42-50). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the device of Krauter with the aperture of Garini for the purpose of less light and depolarization.

Regarding claims 6, 8, 14, and 15, Krauter discloses, in figures 2 and 3, a confocal microscope lens arrangement but does not specifically disclose wherein the coverslip is composed of a transparent polymer with a refractive index of within five percent of 1.38. It would have been obvious to modify the invention to include wherein the coverslip is composed of a transparent polymer with a refractive index of within five percent of 1.38, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use (In re Leshin, 125 USPQ 416).

Regarding claims 7 and 13, Krauter discloses, in figures 2 and 3, a confocal microscope lens arrangement, wherein the coverslip includes a first side and a second side, the first side being in contact with the air filling the space between the exterior and lens housings, and the second side being coated with a polymer. (figures 2 and 3) but does not specifically disclose an immersion media. Garini discloses an immersion media used in a variable focus camera (col. 6, lines 42-50). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the

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device of Krauter with the immersion media of Garini for the purpose of correcting aberrations.

Regarding claim 9, Krauter discloses, in figures 2 and 3, a confocal microscope lens arrangement, wherein the lens assembly housing (23) includes a first end and a second end (figures 2 and 3).

Regarding claim 11, Krauter discloses, in figures 2 and 3, a confocal microscope lens arrangement, wherein the lens assembly (23) includes at least one lens (imager, 21) (col. 3, lines 54-57).

Regarding claim 12, Krauter discloses, in figures 2 and 3, a confocal microscope lens arrangement, wherein the a least one lens (imager, 21) of the lens assembly is in contact with the air between the exterior and lens housings but does not specifically an immersion media. Garini discloses an immersion media used in a variable focus camera (col. 6, lines 42-50). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the device of Krauter with the immersion media of Garini for the purpose of correcting aberrations.

Regarding claim 39, Krauter discloses, in figures 2 and 3, a confocal microscope lens arrangement but does not specifically disclose wherein the immersion medium is a fluid. Garini discloses an immersion media used in a variable focus camera (col. 6, lines 42-50). Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the device of Krauter with the immersion media of Garini for the purpose of correcting aberrations.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDI N. THOMAS whose telephone number is (571)272-2341. The examiner can normally be reached on Monday - Thursday from 6-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Scott J. Sugarman/  
Primary Examiner, Art Unit 2873

BNT  
/Brandi N Thomas/  
Examiner Art Unit 2873